

REMARKS

Reconsideration and allowance are requested. Claims 22, 24, 25, 27 - 31 and 34 - 53 are currently pending in this application.

Rejection of Claims 22, 24, 25, 27 - 30 and 44-45 Under Section 103

The Examiner rejects claims 22, 24, 25, 27 - 30 and 44-45 under Section 103 as being unpatentable over U.S. Patent No. 5,267,261 to Blakeney et al. ("Blakeney et al.") in view of U.S. Patent No. 5,802,465 to Hamalainen et al. ("Hamalainen et al."). Applicants respectfully traverse these rejections and submit that the pending claims are patentable over the prior art of record.

In Applicants' previous Response of September 17, 2003, Applicants amended the claims and argued that Blakeney et al. should not be combined with Hamalainen et al. The Examiner had previously rejected the claims based on various combinations of Blakeney et al., Hamalainen et al. with either U.S. Patent No. 5,963,848 to D'Avello ("D'Avello"), U.S. Patent No. 5,497,505 to Koohgoli et al. ("Koohgoli et al.") or U.S. Patent No. 5,507,007 to Gunmar ("Gunmar"). In this new rejection, the Examiner exclusively rejects all the pending claims only in view of the combination of the two primary references to Hamalainen et al. and Blakeney et al.

In the previous Response, Applicants set forth the burden that the Examiner carries to establish a prima facie case of obviousness. Applicants analyzed whether one of skill in the art would be motivated to combine Blakeney et al. with Hamalainen et al. and explained why these references should not be combined to reject the claims. Applicants believe that those same arguments apply to the new grounds of rejection and therefore incorporate those previous arguments made. A summary of those arguments with additional arguments are set forth below.

Applicants submit that although the Examiner has failed to carry his burden of establishing a prima facie case of obviousness. The Examiner states that Hamalainen et al. and Blakeney et al. are "in the same field of endeavor" and that one of skill in the art would find it obvious to combine these references for the purpose of selecting a channel with a better signal strength than the current one. Upon further investigation, however, Applicants submit that the differences in the subject matter and

focus of Hamalainen et al. compared to Blakeney et al. can only lead to a conclusion that an artisan would have no motivation to combine their teachings. Further, specific statements within the references themselves, rather than providing motivation to combine their teachings, actually urge away from any combination.

Hamalainen et al. teaches concepts for bidirectional transmission of packet data in a cellular system associated with a mobile switching center. (Abstract). The only cellular protocol mentioned by Hamalainen et al. is the Global System for Mobile Communication (GSM) protocol. All the prior art cited by Hamalainen et al. (note the "other publications" listing) are GSM-related references. Although Hamalainen et al. mention the EIA/TIA (Electronic Industries Association/Telecommunication Industry Association) standards, of which CDMA is one, when the detailed description of the invention begins at col. 3, line 63, it is clear that the present invention is limited to GSM.

There are several reasons that it is clear that the disclosure of Hamalainen et al. is only related to the GSM standard. As explained in col. 3, line 63 - col. 4, line 13, they discuss the physical channel of a mobile station communicating with a base station as consisting of time slots where the respective time slots constitute a logical channel. The use of time slots in transmission channels in cellular systems is according to the time division multiple access (TDMA) standard. GSM utilizes a combination of the TDMA concepts and frequency division multiple access (FDMA). See, e.g., GSM Networks: Protocols, Terminology, and Implementation, Artech House Publishers 1999, Chapter 7. The figures are explained by Hamalainen et al. as showing a GSM network. See, e.g., FIG. 1B, Col. 9, lines 53-54. Furthermore, throughout the specification are numerous references to the GSM standard in the description of the Hamalainen et al. invention.

In sum, it would be very clear to an artisan in reviewing the Hamalainen et al. disclosure that they are focused on data transmission according to the GSM standard. This is vitally important in the prima facie obviousness case inasmuch as Blakeney et al. disclose a CDMA soft handoff invention. This becomes clear in both the title and the first line of the Abstract. The code division multiple access (CDMA) standard is well-known to differ dramatically from the TDMA/FDMA (GSM) standards. In the CDMA standard, each user's narrowband signal is spread over a wider bandwidth.

Each signal is spread by a different wideband code, and each of the codes is orthogonal to each other. All the spread-spectrum wideband signals of different users are added together to form a composite signal which is transmitted over the air in the same frequency band. Rather than receiving each user's signal according to individual time slots (TDMA) or individual frequency bands (FDMA), a CDMA signal distinguishes users according to the user's wideband code applied to spread the user's signal.

Blakeney et al. even teaches away from any combination of CDMA concepts with TDMA and FDMA concepts wherein they state "CDMA has significant advantages over these other modulation techniques." Col. 1, lines 24-30. In this regard, Blakeney et al. explain that the CDMA approach differs from and is an improvement over the TDMA/FDMA protocols. In this manner, with regards to the legal determination of whether it is appropriate to combine references, Applicants submit that Blakeney et al. explicitly distance themselves from the GSM standard (based on a combination of TDMA and FDMA) and thus remove any motivation or suggestion to an artisan to combine Blakeney et al. with Hamalainen et al.

For these reasons alone, Applicant submits that the claims are patentable over the prior art of record inasmuch as they cannot be combined to identify each limitation recited in the claims.

Further arguments support the conclusion that these references should not be combined. For Example, MPEP 2143 provides additional requirements:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

With these concepts in mind, Applicants submit that a blending of Blakeney et al. which operates according to the CDMA standard Hamalainen et al. which operates under the TDMA and FDMA standards would clearly require a modification of the respective standards. Requiring such a modification naturally leads to the conclusion that there is no suggestion or motivation to combine the references. For example, to require Blakeney et al. to modify their CDMA approach to conform to the GSM standards would clearly render their CDMA approach unsatisfactory for the intended

Still performing the function just improving data transmission

purpose and principle of the CDMA operation. A similar argument can be made for the necessary alteration of the GSM principles of Hamalainen et al. to blend in the teachings of Blakeney et al. For these additional reasons, Applicants submit that there cannot be any motivation or suggestion to combine these references. Therefore, Applicants submit that claims 22, 24, 25, 27-31 and 34 – 53 are patentable and in condition for allowance.

In the previous Response, Applicants specifically explained how the claims differ from Blakeney et al. and Hamalainen et al. Therefore, these discussions are not repeated here but are incorporated in by reference where applicable.

CONCLUSION

Having addressed the rejection of claims 22, 24, 25, 27 - 31 and 34 - 53 Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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